

REMARKS

The Office Action dated August 24, 2009 has been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto.

Claims 1-5 are pending in this application. Claim 4 has been withdrawn from consideration by the Examiner for being directed to non-elected subject matter. By this Amendment, Claims 1 and 2 are amended and Claim 5 is added. Support for the amendments may be found in the application as originally filed. In particular, support for the amendments to Claims 1, 2, and the subject matter recited by new dependent claim 5 may be found on page 9, lines 7-16; the paragraph bridging pages 12 and 13; page 21, lines 12-23; and Figures 2, 3(a), and 3(b). Applicants respectfully submit that no new matter is added.

Information Disclosure Statement

The Information Disclosure Statement (IDS) filed on December 29, 2005 is objected to for failing to provide a legible copy of each cited foreign patent, and for not complying with 37 C.F.R. § 1.98(a)(2) because the listing of references in the specification is not a proper IDS.

Applicants' representative conducted a telephonic interview with the Examiner on September 23, 2009, during which the foreign patents cited in the IDS filed on December 29, 2005 were discussed. As discussed, the foreign patents were cited in an International Search Report included in the IDS, and should have been considered by the Examiner.

As such, Applicants enclose herein a new IDS with a copy of the foreign references for the convenience of the Examiner. Applicants respectfully request consideration of the disclosed references and withdrawal of the objection to the IDS.

Drawings

The Office Action objects to the drawings, and states Figures 4(a)-4(c) should be designated by a legend such as --Prior Art-- because only that which is old is illustrated.

Applicants have added the legend --Related Art-- in compliance with MPEP § 608.02(g). The cited section of the MPEP provides that “where [figures showing the prior art are] needed to understand applicant’s invention, they may be retained if designated by a legend **such as** ‘Prior Art’” (emphasis added). Applicants note that the term “such as” indicates that “Prior Art” is a suggestion, not a requirement.

Moreover, Applicants submit that should any patent issuing from this application become the subject of litigation, and Figures 4(a)-4(c) are determined *not* to be prior art, then a “Prior Art” label would be considered a non-retractable admission by the trier of fact. Therefore, Applicants respectfully submit that a label of “Related Art” fulfills the statutory and MPEP provisions governing the contents of patent applications.

Withdrawal of the objection is respectfully requested.

Specification

The Abstract is objected to for the following reason: reference characters in the abstract should be in parentheses. The reference characters have been deleted from the Abstract, which has been replaced by a Substitute Abstract enclosed herein. The Substitute Abstract is “a concise statement of the technical disclosure of the patent.”

MPEP § 608.01(b). Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

Claim Rejections Under 35 U.S.C. §§ 102, 103

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shishido (WO 03/027521, hereinafter "Shishido"); and Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shishido in view of Obara (U.S. Patent Application Publication No. 2003/0202722, hereinafter "Obara"). Applicants respectfully traverse the rejections for at least the following reason(s).

Claim 1 recites a fluid bearing device that includes, among other features, "an outside surface which is positioned adjacent to the inner peripheral surface, an outer peripheral edge of the outside surface comprises a **machined surface formed by machining to remove a resin gate portion, and the outside surface of the seal portion is a molded surface except for the machined surface.**" (emphasis added). The claimed invention reduces manufacturing costs, improves assembly efficiency and precision, and lowers costs. See Specification page 7, lines 3-10.

Applicants respectfully submit Shishido and Obara, alone or in any combination thereof, fail to disclose, teach, or suggest the machined surface feature recited by Claim 1.

The Office Action on page 4 asserts that "the limitation of the housing being formed by injection molding of the resin material, and the outer peripheral edge comprises a gate removal portion formed by removing a resin in the shape of a ring is a product-by-process limitation" In general, an external view of the product can clearly identify whether the outer peripheral edge is a molded surface or a machined

surface. See, e.g., Fig. 3(b). Therefore, the subject matter of “an outer peripheral edge of the outside surface comprises a machined surface formed by machining to remove a resin gate portion, and the outside surface of the seal portion is a molded surface except for the machined surface,” as recited in Claim 1, is not a feature of the method, but a structural feature of the final product. See MPEP § 2113 (“[T]he manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.”). This structural feature of the final product is not disclosed or suggested in either Shishido or Obara.

Shishido teaches a bearing unit with a “stepped” feature. This feature is disclosed in Shishido Figures 24, 32, 37-39, 42-43, 46, and 50, which depict a bearing unit with a corner, or “stepped” feature, forming the outer peripheral edge of the outside surface. The Office Action, on pages 3-4, asserts that Figure 46 of Shishido discloses all the claimed structure of Claims 1 and 2.

Shishido teaches a “stepped” feature, and does not disclose, teach, or suggest “an outer peripheral edge of the outside surface comprises a machined surface formed by machining to remove a resin gate portion, and the outside surface of the seal portion is a molded surface except for the machined surface,” as recited by Claim 1.

Accordingly, Applicants respectfully submit that Shishido does not disclose, teach, or suggest each and every feature recited by Claim 1.

To qualify as prior art under 36 U.S.C. § 102, each and every feature recited in a rejected claim must be disclosed in the prior art. For at least the reasons provided above, Applicants submit that Shishido does not disclose or suggest each and every feature recited by pending Claim 1. Accordingly, Shishido does not anticipate, nor

render obvious, the subject matter recited by Claim 1. Therefore, Applicants respectfully submit independent Claim 1 should be deemed allowable over Shishido.

Obara is cited for the teaching “that the outside surface of the seal portion is applied with an oil repellant.” Office Action at 5. Even assuming (without admitting) that Obara teaches application of an oil repellant to the outside surface of the seal portion, Obara does not cure or otherwise address the above discussed deficiencies of Shishido. Thus, the combined teachings of Shishido and Obara do not render Claim 1 obvious because neither reference, nor their combination, teaches or suggests the invention recited by Claim 1.

As such, Applicants submit Claim 1 is not obvious in view of Shishido and Obara, and should be deemed allowable.

Claims 2, 3, and 5 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable for the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein.

Applicants respectfully request withdrawal of the rejections.

Double Patenting

Claims 1-3 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 19-21 of copending Application No. 10/548,170.

Pursuant to MPEP § 804.02 I., “[a] rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope.” Independent Claim 1, from which Claims 2 and 3 depend, has been amended and is no longer coextensive in scope with copending Application No. 10/548,170.

For at least the above reason, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing, Applicants respectfully request consideration of the application, withdrawal of the outstanding rejections and objections, allowance of Claims 1-3 and 5, and the prompt issuance of a Notice of Allowance.

Should the Examiner believe anything further is desirable in order to place this application in a better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, **referencing Docket Number 100725-00176.**

Respectfully submitted,



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